

REMARKS

This Amendment is filed in response to the Office Action mailed June 17, 2009, with Request for Continued Examination (RCE) filed herewith on even date. All rejections and objections are respectfully traversed.

Claims 1 – 5, 7, and 10 – 20 are pending in this case.

Claims 6, and 8 – 9 have been cancelled.

Claims 1, 7, 16, and 19 have been amended to better claim the invention.

Request for Examiner Interview

The Applicant respectfully requests a telephonic interview with the Examiner after the Examiner has had an opportunity to consider this Amendment, but before issuance of the next Office Action. The Applicant's undersigned attorney may be reached at 617-951-2500.

Claim Rejections - 35 U.S.C. §103

At paragraphs 4 – 32 of the Office Action, claims 1 – 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baker, U.S. Patent No. 6,473,741 (hereinafter "Baker"), in view of Dang et al., U.S. Publication No. 2003/0101111 (hereinafter "Dang"), in further view of Stern, U.S. Publication No. 2002/0091602 (hereinafter "Stern").

The Applicant's claim 1, representative in part of the other rejected claims, sets forth (emphasis added):

1. (Currently Amended) A financial services outsourcing method for facilitating outsourcing of tax return preparation services for numerous clients on behalf of a direct service provider serving the numerous clients, the financial services being outsourced to a given outsourcing group, the clients comprising a first set of clients in a first country, having tax return filing obligations for the first country, and comprising a second set of clients in a second country having tax return filing obligations for the second country, the method comprising:

for the direct service provider, loading, onto a remotely accessible part of a host server, client specific financial files and corresponding reference materials, the host server providing access to a remote computer cli-

ent of information concerning the client specific financial files and corresponding reference materials;

preparing tax returns for the clients of the direct service provider by outsourced personnel, the outsourced personnel located outside the first and second countries;

providing the outsourced personnel with limited screen shot access to the host server connected through a remote limited access client located outside the first and second countries, wherein the direct service provider has control of the host server and the client specific financial files and corresponding reference material loaded thereon; and,
monitoring and reporting a status of the tax returns preparation.

By way of background, Baker discloses a system and method for the electronic exchange of tax data between those in the financial service industry. (See Baker, col. 5, lines 34 – 39). Specifically, tax preparation firms submit their databases of income tax data for archival and later retrieval by requesting organizations (“as a result of automated tax preparation, these accounting and tax firms have warehouses of databases of tax returns in digitized format,” See Baker, col. 8, lines 46 – 49). A service bureau then organizes the data from the different firms and coordinates dissemination of the data for a rental fee or user fee to third parties. (See Baker, col. 8, lines 65 – 67). Third parties then retrieve the data for the fee and utilize the data to obtain patterns and relationships that are otherwise not readily evident. (See Baker, col. 2, lines 46 – 51).

By way of further background, Dang provides a technique related to identifying and monitoring taxable transactions, and calculating taxes due on a transaction. (See Dang, paragraph [0008]). Domestic businesses are usually required by state and local authorities to charge sales and/or use tax for most commercial (i.e., sales of goods) transactions relating to goods. (See Dang, paragraph [0002]). Therefore, Dang provides a system that enables merchants to electronically outsource the burden of tax calculation and remittance to state-certified service providers. (See Dang, paragraph [0035]). Specifically, the Dang system collects data based on a financial transaction, calculates any taxes due on the transaction, reports the information to a selected government authority, and periodically remits funds corresponding to the tax owed to the government authority. (See Dang, paragraph [0018]). Dang describes a plurality of servers hosting a plurality of

virtual servers for calculating taxes due on specific transactions. (See Dang, paragraph [0011]).

Stern describes an electronic income tax data processing system. (See Stern, paragraph [0002]). Specifically, a centralized data repository service collects tax information on behalf of an individual and indexes the data with a personal identifier. (See Stern, paragraph [0009]). The individual may then recall the data for use on yearly income tax returns or the government/third party may gain access to the data and perform the individual's tax return. (See Stern, paragraph [0009]).

Applicant respectfully urges that Baker Dang, and Stern, either alone or in combination, fail to teach or suggest Applicant's claimed novel *"providing the outsourced personnel with limited screen shot access to the host server connected through a remote limited access client located outside the first and second countries, wherein the direct service provider has control of the host server and the client specific financial files and corresponding reference material loaded thereon."*

While the Applicant claims a system where outsourced personnel have limited screen shot access to client specific financial files on a host server controlled by a direct service provider, Baker discloses a system that transmits already completed tax information to third parties, Dang discloses a plurality of servers that compute sales tax for merchants, and Stern describes an electronic income tax data processing system.

Applicant claims a system and method for outsourcing tax return preparation services. In Applicant's system, client specific financial files and corresponding reference materials are loaded on a host server by a direct service provider. For example, the financial file may include "the last season tax return as filed, receipts and summary information regarding finances, a W-2 form, 1099 forms," etc... (See Applicant's Specification, page 3, 2nd full paragraph). Using this information, the outsource personnel can prepare the tax returns on behalf of the direct service providers. While preparing the tax returns, the outsource personnel have limited screen shot access to the host server that is controlled by the direct service provider. Advantageously, the direct service provider has ultimate control of the sensitive client specific financial files that are stored on the host server. That is, the clients who utilize the direct service provider may remain confident

that their sensitive tax return information will not be corrupted or misused by the outsource personnel since the outsourced personnel only have limited screen shot access. Further, the clients may remain confident that their tax returns are in fact being done correctly since the direct service provider, who has control of the host server and the information stored thereon, may oversee the actions performed by the outsource personnel.

First, the Applicant notes that there appears to be agreement that Baker fails to teach or suggest this aspect of the Applicant's claim. Specifically, the Office Action states, "Baker fails to explicitly disclose ... providing the outsourced personnel limited access to the server." (See Office Action, paragraph 7). The Applicant notes that Baker simply discloses a system and method for the electronic exchange of tax data between those in the financial service industry. (See Baker, col. 5, lines 34 – 39).

Second, the Applicant respectfully submits that the deficiencies of Baker are not remedied by a combination with Dang. Specifically, Dang simply describes a plurality of servers hosting a plurality of virtual servers for calculating taxes due on a transaction. Specifically, Dang states:

[0011] The system has a first server for hosting a first virtual portal having at least one application for providing e-content to end users.... A second server is provided for hosting a second virtual portal having at least one application for receiving data from the first server and for parsing the data received for XML-based data. A communications infrastructure links the first and second servers to one another. Also provided is a third server for hosting a third virtual portal. This portal has at least one application for processing XML-based data from the second server.... Furthermore, a fourth server is provided for hosting a fourth virtual portal having at least one application for receiving transactional data from the third server.... Moreover, a fifth server is utilized for hosting a fifth virtual portal. This portal has at least one application for receiving XML-based data from the fourth server and converting the second selected first database file from an XML-based format to a TXP- based format for receipt by an automated clearinghouse network.... Finally, a sixth server hosts a sixth virtual portal having at least one application redundant to that of the fourth server, and a seventh server hosts a seventh virtual portal having at least one application redundant to that of the fifth server.

Thus, Dang simply describe a system where a plurality of servers are interconnected to perform the tax calculation. Dang makes no mention of providing outsource

personnel with limited screenshot access to a host server that is controlled by a direct service provider, as is claimed by the Applicant.

Finally, the Applicant respectfully submits that the deficiencies of Baker and Dang are not remedied by a combination with Stern. That is, Stern makes no mention of the Applicant's claimed novel *"providing the outsourced personnel with limited screen shot access to the host server connected through a remote limited access client located outside the first and second countries, wherein the direct service provider has control of the host server and the client specific financial files and corresponding reference material loaded thereon."* Instead, Stern simply describes a centralized data repository service that collects tax information on behalf of an individual and allows a government/third party to perform the individual's tax return. (See Stern, paragraph [0009]).

Accordingly, Applicant respectfully submits that Baker, Dang and Stern, either alone or in any combination, are legally insufficient to render the present claims unpatentable under 35 U.S.C. §103 because of the absence in Baker, Dang, and Stern of Applicant's claimed novel *"providing the outsourced personnel with limited screen shot access to the host server connected through a remote limited access client located outside the first and second countries, wherein the direct service provider has control of the host server and the client specific financial files and corresponding reference material loaded thereon."*

Conclusion

All independent claims are believed to be in condition for allowance.

All dependent claims are dependent from independent claims which are believed to be in condition for allowance.

Accordingly, all dependent claims are believed to be in condition for allowance.

Please charge any additional fee occasioned by this paper to our Deposit Account
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Respectfully submitted,

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